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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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09/072,504 05/04/98 HODOSH

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021831 HM12/1103  
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EXAMINER

ROSE, S

ART UNIT

PAPER NUMBER

1614

DATE MAILED:

11/03/00

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

# Office Action Summary

Application No.

09/072504

Applicant(s)

H0005K1

Examiner

SV08 0258

Group Art Unit

1614

—The MAILING DATE of this communication appears on the cover sheet beneath the correspondence address—

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, such period shall, by default, expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).

## Status

- ☒ Responsive to communication(s) filed on 9/11/2008
- ☐ This action is FINAL.
- ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

## Disposition of Claims

- ☒ Claim(s) 1025 is/are pending in the application.
- Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- ☒ Claim(s) 1025 is/are rejected.
- ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- ☐ Claim(s) \_\_\_\_\_ are subject to restriction or election requirement.

## Application Papers

- ☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.
- ☐ The proposed drawing correction, filed on \_\_\_\_\_ is ☐ approved ☐ disapproved.
- ☐ The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.
- ☐ The specification is objected to by the Examiner.
- ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. § 119 (a)-(d)

- ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
- ☐ All ☐ Some\* ☐ None of the CERTIFIED copies of the priority documents have been received.
- ☐ received in Application No. (Series Code/Serial Number) \_\_\_\_\_
- ☐ received in this national stage application from the International Bureau (PCT Rule 1.7.2(a)).

\*Certified copies not received: \_\_\_\_\_

## Attachment(s)

- ☒ Information Disclosure Statement(s), PTO-1449, Paper No(s). \_\_\_\_\_
- ☒ Notice of Reference(s) Cited, PTO-892
- ☐ Notice of Draftsperson's Patent Drawing Review, PTO-948
- ☐ Interview Summary, PTO-413
- ☐ Notice of Informal Patent Application, PTO-152
- ☐ Other \_\_\_\_\_

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### DETAILED ACTION

The April 29, 1999 response to the election of species requirement amends independent claims 1, 9, 18 and 23, to specify that the composition is not a dentifrice and does not contain an abrasive. The remarks, on Page 4 therein, elects potassium nitrate with carboxypolymethylene and glycerin as a gel.

Claims 1-19, 11, 12, 14-17, and 23-25 are identified as corresponding to the elected species.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

Claims 109, 11, 12, 14-17, and 23-25 are rejected as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Fischer (I) (II) (III) (IV) cited on the attached 892,

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whose May 30, 1997 effective filing date quite clearly antedates applicants May 4, 1998 filing date, claiming the same elected subject matter.

Applicant, as junior party to the same patented invention as claimed in the Fischer patent (I-II-III-IV) must proceed in accordance with 37 CFR 1.68, MTEP section 2308, 2308.01 and 2301.02, to show evidence of possession of the claimed Fischer invention prior to May 30, 1997, the effective filing date of the Fischer patent.

To the extent that the claims as amended are not a dentrifice and do not contain an abrasive, they are not necessarily a dental bleaching gel as elected and see McLaughlin US 6108850 with an effective June 30, 1997 filing date also antedating applicant herein. Wherein the dental bleaching and potassium nitrate desensitizer are in the same composition.

Hodosh (I) (1974) and Hodosh (II) US 3863006 1975 clearly describes the elected species of desensitizer potassium nitrate for the relief of patients who have dentinal hypersensitivity. There is no necessity in either that the potassium nitrate be in a dentrifice with an abrasive.

Haywood et al (September 1994), describes the sensitivity experienced during or after bleaching by subjects undergoing vital tooth bleaching with the known compositions for bleaching teeth.

Art has been cited from the online website for each of Denmat, UltraDent, and Discus Dental to show the conventional tooth bleaching gels with peroxide and the only one of the three that describes a desensitized tooth bleaching gel is the Denmat website which describes Rembrandt Extra Comfort Bleaching Gel as well as Denmat Desensitizing Gel.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Shep Rose, Senior Patent Examiner whose telephone number is (703) 308-4609. The examiner can normally be reached on Mondays thru Thursdays from 8:00a.m. to 5:00p.m..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Marianne Cintins, can be reached on (703) 308-4725. The fax phone number for the organization where this application or proceeding is assigned is (703) 703-308-4556.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1235 .

Shep Rose/ph

October 31, 2000



**SHEP K. ROSE  
PRIMARY EXAMINER  
GROUP 1200**